



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/573,978 | 11/17/2006 | Eral Foxenland | PS02 0303US2 | 4161 |
| 58561 7590 11/13/2008 HARRITY & HARRITY, LLP 11350 RANDOM HILLS ROAD SUITE 600 FAIRFAX, VA 22030 | | | EXAMINER TREAT, WILLIAM M | |
| | | | ART UNIT 2181 | PAPER NUMBER |
| | | | MAIL DATE 11/13/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,978

Applicant(s)

FOXENLAND, ERAL

Examiner

William M. Treat

Art Unit

2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

1. Claims 1-22 are presented for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-11, 13-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Masuyama et al. (Publication No. 2004/0029640).
4. Should applicants be unfamiliar with the "clearly anticipated" reference, they can read relevant information in the notes to form paragraph 7.15 in the MPEP. The basic premise behind a "clearly anticipated" rejection is when the applicants, as individuals of at least ordinary skill in the art, read the reference they will be readily able to recognize the relevance of the teachings of the art to their claims without explanation. However, though not necessary, this examiner usually points applicants to some particularly relevant passages in the reference and provides explanation of his interpretation of applicants' claim language when there might be some possible ambiguity.
5. The examiner would suggest applicants read paragraphs [0098] – [0101], [0156], and [0217] – [0245] and carefully review Figs. 3, 37, and 60-66, at a minimum, before responding. Note that the examiner considers the substance of claim 7 to be inherent in Masuyama's teaching of interrupts. Without such data a computer cannot branch to an

appropriate place in the subsequence or return to an appropriate place in the main sequence.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuyama et al. (Publication No. 2004/0029640).

8. Masuyama taught the invention of claim 10 from which claim 12 depends as well as interrupts (Figs. 62 and 65-66). Okada's system also taught counting iterations of a given activity such as a loop (paragraph [0156] and Fig. 37). The examiner also takes Official Notice of the fact that timer/counter based interrupts are well known in the art. These are such a basic programming tools. Also, interrupts are merely a change of program flow device that can be used as a system manufacturer's design requires. Application of basic tools like timers/counters, loops, and interrupts is merely a straightforward matter for one of ordinary skill and does not rise to the level of patentable differentiation.

9. To assist applicants should they chose to challenge the examiner's Official Notice, the examiner is pointing out that following the KSR decision by the Supreme Court, the Office has changed its policy related to Official Notice. The Office now requires applicants to provide persuasive evidence and/or arguments directly refuting the Official Notice before a supporting reference is to be supplied by the examiner.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuyama et al. (Publication No. 2004/0029640) in view of Mankovitz (WO 98/48566).

11. Masuyama taught the invention of claim 1 from which claim 3 depends. Masuyama also taught interrupting and pausing of the main sequence to execute the subsequence followed by resuming execution of the main sequence when execution of the subsequence is ended (Figs. 62 and 65-66). Okada did not teach setting a resume flag at a position of the main sequence where its execution is interrupted; and when the execution of the sub sequence is ended resuming execution of the main sequence at said position.

12. However, Mankovitz taught setting a resume flag at a position of the main sequence where its execution is interrupted; and when the execution of the sub sequence is ended resuming execution of the main sequence at said position (p. 7, line 19 through p. 8, line 14 and p. 9, line 16-27). One of ordinary skill in the art would be motivated to apply Mankovitz's specific teachings of how one interrupts and pauses the main sequence to execute the subsequence followed by resuming execution of the main sequence when execution of the subsequence is ended, because it represents a known method of handling the stated task which involves image and audio data and which Masuyama left to the skill of one of ordinary skill to implement.

13. MPEP 2141 reads, in part, as follows:

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look

only to the problem the patentee was trying to solve" (*Id.* at __ 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (*Id.*); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try" (*Id.*); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (*Id.*).

In *KSR*, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at __ 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at __ 82 USPQ2d at 1395.

14. The Supreme Court further stated that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his ordinary skill. *Id.* at __ 82 USPQ2d at 1396. When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at __ 82 USPQ2d at 1396.

15. All the elements necessary to produce applicants' invention were known in the art. How one combined such elements to produce applicants' invention was also known in the art. Evidence of this is that applicants' disclosure lacks any detailed description of novel circuitry or novel code necessary to implement applicants' invention. One of ordinary skill would have readily recognized that the results of the combination were predictable. Absent some secondary considerations, not in evidence at this time, applicants invention is obvious over the combination of prior art presented.

16. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication should be directed to William M. Treat at telephone number (571) 272-4175.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2181

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M. Treat/

Primary Examiner, Art Unit 2181